

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Application No.:	10/757,145	:	Examiner:	CHAPMAN, Jeannette E.
Filed:	January 14, 2004	:	TC/A U:	3625
Applicant:	JOLITZ, Randal J.	:	Confirmation No.:	3169
Docket No.:	55616.107495	:	Customer No.:	27526
Title:	STARTER BLOCK ROOFING PRODUCT			

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

APPEAL BRIEF TO BOARD OF PATENT APPEALS AND INTERFERENCES

Appellant submits the following Appeal Brief to the Board of Patent Appeals and Interferences under 35 C.F.R. § 41.37. The Notice of Appeal was filed February 9, 2007.

Table of Contents

	Page
I. The Real Party in Interest.....	4
II. Related Appeals and Interferences.....	5
III. Status of Claims.....	6
IV. Status of Amendments.....	7
V. Summary of the Claimed Subject Matter.....	8
VI. Grounds of Rejection to be Reviewed on Appeal.....	12
VII. Argument.....	13
A. Obviousness	13
B. Claims 1-4 and 8-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,852,934 to Kirkhuff in view of U.S. Patent No. 4,279,106 to Gleason et al.	14
(1) The Rejection.....	14
(2) Discussion.....	15
C. Claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Kirkhuff in view of Gleason et al. as applied to Claim 1 and further in view of U.S. Patent No. 5,953,862 to Earhardt.	25
(1) The Rejection.....	25
(2) Discussion.....	25
D. Claims 6-7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kirkhuff in view of Gleason as applied to Claim 1 and further in view of U.S. Patent No. 2,142,996 to Bussey.	27
(1) The Rejection.....	278
(2) Discussion.....	28
E. Claims 12-15 and 19-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 2,193,233 in view of Kirkhuff in view of Gleason and further in view of U.S. Patent No. 6,199,338 to Hudson, Jr. et al.	29
(1) The Rejection.....	29
(2) Discussion.....	31
F. Claim 16 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Hardy in view of Kirkhuff in view of Gleason further in view of Hudson, Jr. as applied to Claim 12 and further in view of Earhardt.....	38
(1) The Rejection.....	38
(2) Discussion.....	399

G. Claims 17-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hardy in view of Kirkhuff in view of Gleason further in view of Hudson, Jr. as applied to Claim 12 and further in view of Bussey.	40
(1) The Rejection.....	411
(2) Discussion.....	41
H. MPEP § 707.07(f)	42
VIII. Conclusion	433
IX. Claims Appendix.....	44
X. Evidence Appendix	49
XI. Related Proceedings Appendix	50

I. The Real Party in Interest

The real party in interest for the above-referenced application is TAMKO Roofing Products, Inc., having a principal place of business at 220 West 4th Street, P.O. Box 1404, Joplin, Missouri 64802. TAMKO Roofing Products, Inc. is the assignee and sole owner of the entire right, title and interest in and to the invention and the present patent application.

II. Related Appeals and Interferences

Appellant is not aware of any appeals or interferences which would directly affect or be directly affected by this Appeal or would have a bearing on the Board's decision in this Appeal.

III. Status of Claims

Claims 1-23 are currently pending with Claims 1 and 12 being independent.

Claims 1-23 are the subject of this appeal and stand rejected under 35 U.S.C. § 103(a).

IV. Status of Amendments

The present application was filed on January 14, 2004. A first non-final rejection was mailed on March 24, 2006. On August 24, 2006, an Amendment and Response to the Non-final Rejection was filed by Appellant. A Final Rejection was then mailed on November 9, 2006. In conjunction with a Notice of Appeal, an Amendment After Final was filed by Appellant on February 9, 2007 in response to the Final Rejection. An Advisory Action was then mailed on February 28, 2007. No further amendments have been filed and all of the above-referenced amendments were entered into the record.

V. Summary of the Claimed Subject Matter

Claims 1-23 remain pending in the present application with Claims 1 and 12 being independent. Support for independent Claims 1 and 12 is set forth below by reference to the specification by paragraph number and to the drawings by reference characters.

The principal focus of the present invention is on a starter block for use in the starter course of a roofing project to facilitate the subsequent positioning of shingles upon a hip roof without causing the shingles to substantially bend. The starter block has a tapered thickness, that is, the height of the front surface is greater than the height of the back surface. In one embodiment, the height of the front surface is about twice the height of the back surface. Otherwise, the starter block is generally rectangular. In one embodiment, the starter block is formed from a composite material such as a combination of a polymer component and a filler component. The starter block may also include at least one nib extending from each of its side surfaces and at least one nailing zone on its top surface. A roofing system that incorporates a course of the starter blocks coupled to the eaves of the roof and at least one course of shingles positioned to lie flat on and at least partially overlap the course of starter blocks with the shingles extending back to the upper surface of the roof without substantially bending or flexing the shingles in the one course is also provided by the present invention.

Claim 1 is an independent claim directed to a starter block and reads:

“A composite starter block having a unitary construction for facilitating the subsequent positioning of shingles upon a hip roof, said starter block comprising:

a top surface, two side surfaces, a front surface and a back surface;

wherein each of said top surface, said front surface and said back surface has a generally rectangular shape;

wherein the height of said front surface is greater than the height of said back surface;

wherein said two side surfaces are tapered; and

wherein a shingle placed flat on said top surface will extend back to said roof without substantially bending.”

Support in the disclosure for each element of this claim is shown in the chart below.

Claim 1. <u>A composite starter block having a unitary construction for facilitating the subsequent positioning of shingles upon a hip roof, said starter block comprising:</u>	Figures 1-5: Starter Block 10 Paragraph [0011] Paragraph [0022] Paragraph [0023] Paragraph [0036] Paragraph [0037]
<u>a top surface, two side surfaces, a front surface and a back surface;</u>	Figures 1-3: Top surface 20, Bottom surface 30, Front surface 40, Back surface 50, Side surface 60 and Side surface 70 Paragraph [0023]
<u>wherein each of said top surface, said front surface and said back surface has a generally rectangular shape;</u>	Figures 1-3: Top surface 20, Bottom surface 30, Front surface 40 and Back surface 50 Paragraph [0023]
<u>wherein the height of said front surface is greater than the height of said back surface;</u>	Figure 3: Front surface 40, Back surface 50, Front surface height H_F , and Back surface height H_B Paragraph [0012] Paragraph [0022] Paragraph [0024]
<u>wherein said two side surfaces are tapered; and</u>	Figure 3: Non-rectangular side surfaces 60 and 70 Paragraph [0012] Paragraph [0022] Paragraph [0024]

<u>wherein a shingle placed flat on said top surface will extend back to said roof without substantially bending.</u>	Figures 4-5: Starter block 10, Shingle 210, Shingle back edge 260, and Roof 150 Paragraph [0022] Paragraph [0029] Paragraph [0031] Paragraph [0038]
---	---

Claim 12 is an independent claim directed to a roofing system and reads:

“A roofing system for covering and protecting a roof, said roofing system comprising:

a course of starter blocks coupled to the eaves of said roof, with each of said starter blocks having a unitary construction and comprising a top surface, two side surfaces, a front surface and a back surface, wherein each of said top surface, said front surface and said back surface has a generally rectangular shape, wherein the height of said front surface is greater than the height of said back surface; and wherein said two side surfaces are tapered; and

at least one course of shingles coupled to said roof, the first course of said shingles positioned to lie flat on and at least partially overlap said course of starter blocks with said shingles extending back to said roof without substantially bending.”

<u>Claim 12. A roofing system for covering and protecting a roof, said roofing system comprising:</u>	Figures 1-5: Starter Block 10, Shingle 210, and Roof 150 Paragraph [0003]
<u>a course of starter blocks coupled to the eaves of said roof, with each of said starter blocks having a unitary construction and comprising a top surface, two side surfaces,</u>	Figures 1-5: Top surface 20, Bottom surface 30, Front surface 40, Back surface 50, Side surface 60, Side surface 70, Shingle 210, and Roof 150

<u>a front surface and a back surface,</u>	Paragraph [0022] Paragraph [0023] Paragraph [0036] Paragraph [0037]
<u>wherein each of said top surface, said front surface and said back surface has a generally rectangular shape,</u>	Figures 1-3: Top surface 20, Bottom surface 30, Front surface 40 and Back surface 50 Paragraph [0023]
<u>wherein the height of said front surface is greater than the height of said back surface, and</u>	Figure 3: Front surface 40, Back surface 50, Front surface height H_F , and Back surface height H_B Paragraph [0012] Paragraph [0022] Paragraph [0024]
<u>wherein said two side surfaces are tapered; and</u>	Figure 3: Non-rectangular side surfaces 60 and 70 Paragraph [0012] Paragraph [0022] Paragraph [0024]
<u>at least one course of shingles coupled to said roof, the first course of said shingles positioned to lie flat on and at least partially overlap said course of starter blocks with said shingles extending back to said roof without substantially bending.</u>	Figures 4-5: Starter block 10, Shingle 210, Shingle back edge 260, and Roof 150 Paragraph [0022] Paragraph [0029] Paragraph [0031] Paragraph [0038]

VI. Grounds of Rejection to be Reviewed on Appeal

Appellant respectfully submits that the Examiner has not met her burden in establishing a prima facie case of obviousness in the following rejections:

A. Claims 1-4 and 8-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,852,934 to Kirkhuff in view of U.S. Patent No. 4,279,106 to Gleason et al.

B. Claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Kirkhuff in view of Gleason et al. as applied to Claim 1 and further in view of U.S. Patent No. 5,953,862 to Earhardt.

C. Claims 6-7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kirkhuff in view of Gleason as applied to Claim 1 and further in view of U.S. Patent No. 2,142,996 to Bussey.

D. Claims 12-15 and 19-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 2,193,233 in view of Kirkhuff in view of Gleason and further in view of U.S. Patent No. 6,199,338 to Hudson, Jr. et al..

E. Claim 16 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Hardy in view of Kirkhuff in view of Gleason further in view of Hudson, Jr. as applied to Claim 12 and further in view of Earhardt.

F. Claims 17-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hardy in view of Kirkhuff in view of Gleason further in view of Hudson, Jr. as applied to Claim 12 and further in view of Bussey.

VII. Argument

A. Obviousness

When determining the question of obviousness, underlying factual questions are presented which include (1) the scope and content of the prior art; (2) the level of ordinary skill in the art at the time of the invention; (3) objective evidence of nonobviousness; and (4) the differences between the prior art and the claimed subject matter. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

Appellant does not contest that most of the references cited and relied on by the Examiner have at least marginal pertinence to the particular problem in that the references disclose roofing materials. Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 1535, 218 USPQ 8781, 8786 (Fed. Cir. 1983). Objections to individual references are addressed in the discussion section relating to the rejections hereinbelow.

The person of ordinary skill in the art is a hypothetical person who is presumed to know the relevant prior art. Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc., 807 F.2d 955, 962, 1 USPQ2d 1196, 1201 (Fed. Cir. 1986). The level of ordinary skill in the art of roofing materials may be determined by looking to the references of record. In re GPAC, Inc., 57 F.3d 1573, 35 USPQ2d 1116 (Fed. Cir. 1995). The references of record in this case reveal a moderate level of sophistication in roofing material manufacturing and installation is associated with one of ordinary skill. Thus, Appellant submits that, as substantiated by the cited references, those with a significant experience in the roofing material manufacturing and/or installation industries, including a skilled roofer, or the like would most likely be a person with ordinary skill in the this field of endeavor.

With respect to objective evidence of nonobviousness, Appellant submits that the record supports the conclusion that there are long-felt but unsolved needs met by the present invention. The present invention is directed to the particular problem of providing a starter block that substantially eliminates any gaps between the front portion of the first course shingles and the upper or top surface of the product underlying the first course shingle and/or any gap between the back of the first course shingle and the roof so that the first course shingles may be installed without substantially bending or breaking. Additionally, the present invention is directed to the problem of providing a product that accomplishes the above and that is usable with different types of shingles and capable of being mass-produced.

B. Claims 1-4 and 8-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,852,934 to Kirkhuff in view of U.S. Patent No. 4,279,106 to Gleason et al.

(1) The Rejection

In particular, it was asserted that “Kirkhuff discloses a starter block for facilitating the subsequent positioning of shingles upon a hip roof; the starter block 72 comprising:

1. a top surface 74
2. two side surface [sic]
3. a front surface 82 having a rectangular face
4. a back surface 80 having rectangular face [sic]
5. the height of the front surface is greater than that of the back

surface

6. a shingle 14 placed flat on the top surface 74 will extend back to the roof without bending. See figure 4

7. the width of the starter strip is substantially equal to the width of the shingle, column 8, lines 45-50

8. a nailing zone on the top surface, figure 4

9. the starter block is made of polymer material but does not include a filler commonly used in shingles as shown by Kirkhuff, column 6, lines 46-64. It would have been obvious to one of ordinary skill in the art to have the starter block made of not only a foam polyurethane but also like the shingle to create a uniform structure to the roof

10. the front surface is shown in figure 3 to be twice the height of the back; the particular dimensions of the starter block/shingle has been considered a matter of choice; one of ordinary skill in the art would have appreciated the dimension of the shingle to be used and would have fashioned the starter block accordingly

11. the top surface resembles a slate

12. a coarse [sic] of starter blocs [sic].”

Further, it was acknowledged that “Kirkhuff lacks the tapered side edges.” However, it was asserted that “tapered side edges [are] known in the art of shingles as shown by Gleason et al., element 14, figure 3.” Therefore, the Examiner concludes “[i]t would have been obvious to one of ordinary skill in the art to modify Kirkhuff to taper any edge to give a finished appearance to a starter block as shown by Gleason et al..”

(2) Discussion

The primary cited reference to Kirkhuff is directed to an interlocking simulated shingle arrangement providing interlocking interconnections between the simulated shingles in one course with simulated shingles in adjacent courses and interlocking sealing interconnection between adjacent shingles in the same course. Kirkhuff uses an

eaves starter strip that generally simulates the rear portion of the simulated shingle and has a body member that is provided with a top plate substantially identical to the shingle top plate and a bottom plate having a rear edge that is spaced from the rear edge of the body member a preselected longitudinal distance. The Kirkhuff starter strip is therefore specifically designed to be used with the Kirkhuff simulated shingles of a special design and configuration. The Kirkhuff patent is therefore nothing more than a part of the background of the unsolved need for Appellant's invention. The fact that Kirkhuff does not teach or suggest a starter block that is usable with different types of shingles so as to prevent the first course of shingles from substantially bending indicates that Kirkhuff had no knowledge of the problem addressed by the present invention. Therefore, the Kirkhuff patent contains no explicit or implicit teaching that is actually relevant to the present claimed invention. Such objective evidence of nonobviousness must be considered if presented. Pentech, Inc. v. Graphic Controls Corp., 776 F.2d 309, 315, 227 USPQ 766, 770 (Fed. Cir. 1985).

In determining whether obviousness is established by the teachings of the prior art, "the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art." Cable Electric Products, Inc. v. Genmark, Inc., 770 F.2d 1015, 1025, 226 USPQ 881, 886-887 (Fed. Cir. 1985); In re GPAC, 35 USPQ at 1123. To invalidate claimed subject matter for obviousness, the combined teachings of the prior art references must suggest, expressly or by implication, the improvements embodied by the present invention. In re Sernaker, 702 F.2d 989, 217 USPQ 1 (Fed. Cir. 1983).

“In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based on the prior art.” In re Fritch, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). “Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under Section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so.” ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

The Examiner, in both the non-final and final rejection, acknowledged that the Kirkhuff reference does not contain within its four corners a teaching adequate to support the obviousness rejection and, faced with this deficiency, the Examiner has resorted to dubious, undocumented assertions of what would have been obvious to one skilled in the art based on a reading of Kirkhuff. Furthermore, the Examiner’s statement that “[i]t would have been obvious to one of ordinary skill in the art to modify Kirkhuff to taper any edge to give a finished appearance to a starter block as shown by Gleason et al.” is completely inapplicable to the claimed invention. Appellant does not claim that the purpose of the tapered side edges is to give a finished appearance. Rather, Appellant specifically claims that the starter block’s two side surfaces are tapered so that a shingle placed flat on the top surface will extend back to the roof without substantially bending. Thus, the Examiner’s assertion as to what would have been obvious to one of ordinary skill in the art is not only dubious and undocumented but is also inapplicable to Appellant’s claimed invention.

Appellant respectfully submits that Kirkhuff does not teach or suggest the claimed invention. In particular, Kirkhuff fails to teach or suggest at least the following elements of Appellant's claimed invention: (1) a composite starter block having a unitary construction; and (2) tapered side surfaces such that a shingle placed flat on the top surface of the starter block will extend back to the roof without substantially bending.

In his rejections, the Examiner states that "Kirkhuff discloses a starter block for facilitating the subsequent positioning of shingles upon a hip roof, the starter block 72 comprising:" However, Appellant's Claim 1 and Claim 12 each recite that the starter block has a unitary construction. Both the non-final and the final Office Action fail to even mention much less discuss this feature of Appellant's invention. Nowhere in either Office Action does the Examiner claim that Kirkhuff teaches a starter block having a unitary construction nor can the Examiner so claim. Rather than a composite starter block having a unitary construction, Kirkhuff teaches a separate starter strip 70 and a separate body member 72 having a separate top plate 74 and a separate bottom plate 76. These separate components are then assembled together to form Kirkhuff's eaves starter strip. Thus, Kirkhuff fails to teach or suggest a composite starter block having a unitary construction.

The secondary reference to Gleason also fails to teach or suggest a composite starter block having unitary construction. In fact, Gleason does not teach or suggest starter blocks at all. Rather, Gleason only briefly mentions that "[p]reliminary to applying panels to a roof, a metal starter strip (not shown) is nailed to the roof and extends closely adjacent and parallel to the eave." Furthermore, the Examiner makes no

claim that Gleason does teach or suggest a composite starter block having a unitary construction.

Moreover, the Examiner offers no explanation or factual justification for his extrapolation of the Kirkhuff and Gleason patents to the present claimed invention. Rather, the Examiner merely states that Appellant's invention is obvious and does not provide any support or justification whatsoever for how or why these references teach or suggest a composite starter block having a unitary construction. However, the burden is on the Examiner to show that Appellant's claimed invention is disclosed in the cited references. The Examiner has not met his burden with respect to this feature of Appellant's claimed invention.

With respect to the second undisclosed feature of the claimed invention, Appellant respectfully submits that Kirkhuff also fails to teach or suggest a starter block having tapered side surfaces wherein a shingle placed flat on the top surface of the starter block will extend back to the roof without substantially bending. Turning to Appellant's Figures 1-5 and paragraph [0024], "the height H_F of the front surface 40 [of starter block 10] is greater than the height H_B of back surface 50. Accordingly, the heights of side surfaces 60 and 70 decrease or taper from the front of starter block 10 to the back." As shown most clearly in Figs. 3 and 5, Appellant's side surfaces substantially decrease in height from front to back and the tapering goes far enough back so as to provide a flat or planar surface for a subsequent course of shingles. Referring specifically to paragraph [0030], the tapered side surfaces of Appellant's starter block enable the bottom surface of an installed shingle 210 to lie flat on the top surface 20 of the starter block 10 "with its front surface 250 in a planar relationship with the front surface 40 of starter block 10."

Thus, as can be seen in Fig. 5, the shape and size of starter block 10 and, in particular, the tapered side surfaces of starter block 10 cause the back edge 260 of shingle 210 to be in contact with the roof 150 when shingle 210 is installed overlying starter block 10.

Notably, the back edge 260 of shingle 210 is in contact with roof 150 even though shingle 210 is lying flat along the length of the top surface 20 of the starter block 10. The term “flat” as defined in Appellant’s specification, claims, and in Webster’s Ninth New Collegiate Dictionary cannot be interpreted to mean a surface that is “stepped.” For example, Webster’s states that the word “flat,” when used as an adjective or adverb, means “lying at full length . . . ; having a relative smooth or even surface; arranged or laid out to be level or even. With this configuration, shingle 210 is not bent, flexed, curved or bowed as it extends back beyond starter block 10. Nor can it require a “stepped” lower surface as it must be “flat”. Thus, it is the tapered side surfaces of starter block 10 that allows shingle 210 to be installed so that it remains planar or flat between its back edge 260 which is contact with roof 150 and its front edge 250.

It is admitted in the Office Action that Kirkhuff fails to teach or suggest tapered side edges. Rather, Kirkhuff teaches a starter strip 70 that generally simulates the rear portion 38 of the simulated shingle 10 and has a body member 72 that is provided with a top plate 74 and a bottom plate 76 having a rear edge 78 that is spaced from the rear edge 80 of the body member 72 a preselected longitudinal distance. As shown most clearly in Fig. 4, Kirkhuff’s body member 72 extends from forward face 82 to the rear edge 80 wherein rear edge 80, rather than tapering to permit shingle body 14 to “be placed flat on said top surface” as claimed by Appellant, instead “abuts against the base portion 34” of the “stepped” shingle body member 14. See Col. 9, lines 6-13. The forward face 82 is

provided with a wall 84 that defines a plurality of grooves 86 extending transversely from bottom to top to provide interconnectivity with subsequent shingle courses.

However, it is asserted by the Examiner that “tapered side edges is [sic] known in the art of shingles as shown by Gleason et al., element 14, figure 3.” Appellant respectfully submits that this combination is inapposite. First, there is no teaching or suggestion in Gleason to provide a starter block at all. Gleason only teaches shingles. The sole teaching by Gleason is for a metal starter strip. In response to Appellant’s previously-submitted arguments in this vein, the Office Action states that “[r]eason [sic] expectation of success has been shown such as ease of installation. The prior art suggest [sic] the claimed limitation or the limitations are with in [sic] the scope of the inventions of the prior art. The prior art teaches the claimed limitations thus the same [sic] may be termed a starter block. The secondary references are not bodily incorporated into the teaching of the base references but are cited to show some favorable feature known in the building or roof industry.” Appellant respectfully traverses this mischaracterization of what constitutes a prima facie case of obviousness.

First, the Office Action has failed to demonstrate the suggestion or motivation, present either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the reference teachings as required by the first criteria of obviousness. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 16 USPQ2d 1430 (Fed. Cir. 1990). The Office Action appears to be asserting that, because the Gleason reference allegedly contains tapered side edges, “the prior art teaches the claimed limitations thus the same

may be termed a starter block.” Appellant respectfully submits that just because the shingles taught by Gleason allegedly possess tapered side edges that does not mean that the shingles somehow become starter blocks. There is absolutely no suggestion or motivation in Kirkhuff or Gleason to combine a feature of Gleason’s shingles with Kirkhuff’s starter strip.

In fact, Kirkhuff teaches away from this combination because Gleason’s tapered side edges would render Kirkhuff’s starter strip inoperable for its intended purpose. First, if Kirkhuff’s side edges tapered as allegedly taught by Gleason or as disclosed by Appellant, the rear surface 80 of the body member of the eaves starter strip 70 would not be capable of abutting against the base portion 34 of Kirkhuff’s shingle. Instead, a substantial gap between the top plate of the starter strip body member and the bottom surface of the forward portion of the shingle. Furthermore, the sealing interconnectivity provided by grooves 86 would be substantially diminished because of the lack of structural integrity created by the gap between the starter strip body member and the shingle. Thus, the Examiner’s modified configuration would destroy Kirkhuff’s stated purpose of providing interlocking sealing interconnection between adjacent shingles in the same course to provide improved thermal insulation, effective structural integrity and reduced environmental deterioration.

Moreover, this modified configuration does not allow a shingle placed flat on the top surface to extend back to the roof without substantially bending. Applicant’s tapered side edges permit a shingle having a planar or flat bottom surface to lie flat on the planar top surface of Appellant’s starter block. If the Kirkhuff starter strip possessed tapered side edges, Kirkhuff’s shingle would not lie flat on the top surface of the starter strip due

to the abutting front edge 34 of Kirkhuff's shingle. If the shingle does not lie flat against the top surface of the starter block, it will bend. Therefore, the Examiner's proposed modification of Kirkhuff's starter strip, even if such a modification were operable, would still not meet the terms of Appellant's claimed invention.

Additionally, Kirkhuff discloses a dependent starter system. That is, Kirkhuff requires a specific starter/shingle alignment due to the interlocking nature of the starter strip and shingle. As a result, Kirkhuff's starter strip cannot be used with any shingle system but can only be used with Kirkhuff's shingle. Adding tapered edges to Kirkhuff's starter strip would destroy the interlocking nature of the starter strip and shingle and would render it inoperable for use with Kirkhuff's shingles. Since the proposed modification of Kirkhuff would render Kirkhuff's starter strip unsatisfactory, no suggestion or motivation to make the proposed modification exists. In re Gordon, 221 USPQ 1125 (Fed. Cir. 1984).

Moreover, Appellant respectfully submits that Gleason does not, in fact, teach tapered side edges at all. Element 14 in figure 3 does not designate a tapered side edge of the shingle as asserted by the Examiner, but rather designates the lower edge 14 of roofing panel 10. *See* Col. 2, lines 10-16. Rather, Gleason teaches a roofing "panel that includes an upper, relatively straight-line edge, two side edges at substantially 90 degrees to the upper edge, and a lower, irregular edge having the appearance of a plurality of individual roofing shakes." Col. 1, lines 29-35. Moreover, "[t]he undersurface of each panel includes a *stepped* arrangement . . ." (*emphasis added*) Col. 1, lines 45-46.

With respect to Claim 2, neither Kirkhuff nor Gleason teaches a starter block wherein the width of the starter block is substantially equal to the width of the shingle.

Rather, Kirkhuff teaches that the eaves starter strip may be provided with channels in the forward face thereof to simulate division between shingles when it is fabricated in lateral lengths exceeding the length of a single shingle. Gleason teaches only a metal starter strip and does not teach that this starter strip has a width that is substantially equal to the width of the shingle. Thus, Kirkhuff and Gleason, individually and in combination, fail to teach or suggest Appellant's starter block having tapered side edges wherein a shingle placed flat on the planar top surface of the starter block will extend back to the roof without substantially bending. Moreover, both references also fail to teach or suggest a starter block wherein the width of the starter block is substantially equal to the width of the shingle.

Prima facie obviousness requires that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references. No such suggestion or motivation exists in either Kirkhuff or Gleason to provide a composite starter block having unitary construction, tapered side edges wherein a shingle placed flat on the top surface of the starter block will extend back to the roof without substantially bending, and a width substantially equal to the width of the shingle. Moreover, there is no expectation of success in the combination of Kirkhuff and Gleason since neither discloses these elements of Appellant's claimed invention and the proposed modification of Kirkhuff would render Kirkhuff's starter strip unsatisfactory for its intended purpose. Finally, the prior art references must teach or suggest all the claim limitations. As discussed above, neither Kirkhuff nor Gleason teach or suggest all of the elements of Appellant's

independent Claims 1 and 12. Unless all the elements are taught by the references, there can be no success in modifying them.

Thus, at the time the present invention was made, both Kirkhuff and Gleason fail to teach or describe all of the limitations claimed by Appellant in independent Claims 1 and 12 and the claims depending therefrom. Accordingly, Claims 1-4 and 8-13 are nonobvious under § 103(a) and Appellant respectfully requests that this rejection be reversed.

C. Claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Kirkhuff in view of Gleason et al. as applied to Claim 1 and further in view of U.S. Patent No. 5,953,862 to Earhardt.

(1) The Rejection

In particular, the Office Action asserted that “[t]he nailing zone is not indented as shown by earhardt et al, [sic] see abstract. It would have been obvious to one of ordinary skill in the art to modify Kirkhuff to include the indented nailing zone to accommodate proper placement of the nail upon installation of the starter block and shingles.”

Appellant has interpreted this statement to mean that it is the Kirkhuff reference that does not teach a nailing zone.

(2) Discussion

As discussed above, neither Kirkhuff nor Gleason teach or suggest a composite starter block having a unitary construction and tapered side edges wherein a shingle placed flat on the top surface of the starter block will extend back to the roof without substantially bending. Similarly, Earhardt also fails to teach or suggest a composite starter block having a unitary construction and tapered side edges wherein a shingle placed flat on the top surface of the starter block will extend back to the roof without

substantially bending. Moreover, Earhardt also fails to teach or suggest a nailing zone on the top surface of the starter block. Rather, Earhardt merely teaches a plastic shim for use in building. The asserted “nailing zone” taught by Earhardt serves a different purpose than that of the claimed invention. Earhardt’s nailing divot is not for ensuring proper nail placement but rather for weakening the fastening strength of the nail by causing the shim to split in the indented area.

Furthermore, Earhardt is not analogous art. In order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the invention was concerned. In re Oetiker, 24 USPQ2d 1443 (Fed. Cir. 1992). Appellant’s field of endeavor relates to roofing and, in particular, a starter block for roofing shingles. The Earhardt reference, on the other hand, is directed to shims which are used to fill gaps, level items such as doors, windows or cabinets, or to adjust such items to fit properly. This reference deals with completely different subject matter and would not logically have commended itself to the inventor’s attention in considering the problem at hand in the present invention.

Prima facie obviousness requires that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references. No such suggestion or motivation exists in Kirkhuff, Gleason, or Earhardt to provide a composite starter block having unitary construction, tapered side edges wherein a shingle placed flat on the top surface of the starter block will extend back to the roof without substantially bending, and a nailing zone on the top surface of the starter block. One skilled in the art would also not

look to Earhardt for motivation because it is nonanalogous art. Moreover, there is no expectation of success in the combination of Kirkhuff, Gleason, and Earhardt since none of these references disclose a composite starter block having unitary construction, tapered side edges wherein a shingle placed flat on the top surface of the starter block will extend back to the roof without substantially bending, and a nailing zone on the top surface of the starter block. Finally, the prior art references must teach or suggest all the claim limitations. As discussed above, Kirkhuff, Gleason, and Earhardt all fail to teach or suggest all of the elements of Appellant's independent Claim 1. Unless all the elements are taught by the references, there can be no success in modifying them.

Thus, at the time the present invention was made, Kirkhuff, Gleason, and Earhardt alone or in combination, all fail to teach or describe all of the limitations claimed by Appellant in independent Claim 1 and its dependent Claim 5. Accordingly, Claim 5 is nonobvious under § 103(a) and Appellant respectfully requests that this rejection be reversed.

D. Claims 6-7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kirkhuff in view of Gleason as applied to Claim 1 and further in view of U.S. Patent No. 2,142,996 to Bussey.

(1) The Rejection

It was acknowledged that "Kirkhuff lacks the nibs extending from the side surface of the shingle/starter block." However, it was asserted that "Bussey discloses nibs 24/25/26 extending from the side surface of his roofing shingle 27. It would have been obvious to one of ordinary skill in the art [sic] to include these nibs on the starter block/shingle [sic] of Kirkhuff to provide an aligning means upon installation of the starter block/shingles on the roof."

(2) Discussion

As discussed above, neither Kirkhuff nor Gleason teach or suggest a composite starter block having a unitary construction and tapered side edges wherein a shingle placed flat on the top surface of the starter block will extend back to the roof without substantially bending. Moreover, neither Kirkhuff nor Gleason teach or suggest a nib extending from the side surfaces. Similarly, Bussey also fails to teach or suggest a composite starter block having a unitary construction, tapered side edges wherein a shingle placed flat on the top surface of the starter block will extend back to the roof without substantially bending, and a nib extending from the side surfaces. Rather, Bussey merely teaches metallic shingles that are symmetrical, reversible and interlockable. Contrary to the Office Action's assertions, the "nib" taught by Bussey is not a spacer. Rather, it is an integral part of Bussey's interlocking system. In the present invention, the claimed nib or spacer tab ensures consistent spacing.

Prima facie obviousness requires that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references. No such suggestion or motivation exists in Kirkhuff, Gleason, or Bussey to provide a composite starter block having unitary construction, tapered side edges wherein a shingle placed flat on the top surface of the starter block will extend back to the roof without substantially bending, and a nib extending from the side surfaces. Moreover, there is no expectation of success in the combination of Kirkhuff, Gleason, and Bussey since none of these references disclose these elements of Appellant's claimed invention. Finally, the prior art references must teach or suggest all the claim limitations. As discussed above, Kirkhuff, Gleason, and

Bussey all fail to teach or suggest all of the elements of Appellant's independent Claim 1. Unless all the elements are taught by the references, there can be no success in modifying them.

Thus, at the time the present invention was made, Kirkhuff, Gleason, and Bussey, alone or in combination, fail to teach or describe all of the limitations claimed by Appellant in independent Claim 1 and its dependent Claims 6 and 7. Accordingly, Claims 6 and 7 are nonobvious under § 103(a) and Appellant therefore respectfully requests reversal of this rejection.

E. Claims 12-15 and 19-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 2,193,233 in view of Kirkhuff in view of Gleason and further in view of U.S. Patent No. 6,199,338 to Hudson, Jr. et al.

(1) The Rejection

It was asserted that "Hardy discloses a starter block 11 for facilitating the subsequent positioning of shingles upon a hip roof, the starter block 1 [sic] comprising:

13. a top surface
14. two side surfaces
15. a front surface having a rectangular face
16. a back surface having rectangular face [sic]
17. the height of the front surface is greater than that of the back

surface

18. a shingle 12/13/14 placed flat on the top surface will extend back to the roof without bending. See figure 2

19. the width of the starter strip is not disclosed as being equal to the width of the shingle

20. a nailing zone on the top surface, figure 3

21. the starter block is made of polymer material but does not include a filler commonly used in shingles as shown by Kirkhuff, column 6, lines 46-64. It would have been obvious to one of ordinary skill in the art to have the starter block made of not only a foam polyurethane but also like the shingle to create a uniform structure to the roof [sic]

22. the front surface is to be twice the height of the back; the particular dimensions of the starter block/shingle has been considered matter of choice; one of ordinary skill in the art would have appreciated the dimension of the shingle to be used and would have fashioned the starter block accordingly

23. the top surface resembles a slate

24. a coarse [sic] of starter blocks [sic].”

Further, it was asserted in the Final Office Action that “Hardy shows the tapered side edges. However, the tapered side edges is known in the shingles [sic] as shown by Gleason et al., element 14, figure 3.” Appellant has interpreted this statement to actually be stating that Hardy does not show tapered side edges because the Final Office Action also states that “[i]t would have been obvious to one of ordinary skill in the art to modify Hardy to taper any edge to give a finished or different appearance to a starter block as shown by Gleason et al..” Moreover, the Final Office Action states “Hudson discloses a course of starter shingles of the same length as the shingle. Though Kirkhoff [sic] hints at a course of starter blocks, Hudson discloses the course of starter shingles

commensurate in dimension with the shingles. It would have been obvious to one having ordinary skill in the art to modify Hardy to include a starter shingle commensurate in dimension with the starter shingle in order to facilitate installation as suggested by Hudson and Kirkhoff. [sic]"

(2) Discussion

The primary reference to Hardy is directed to means for covering the roof of a building with thin strips or shingles of cement mortar or concrete. The preferred embodiment provides a simulated shingle including a body member having an upper surface, a lower surface, a forward surface, a rear surface spaced from the forward surface and a pair of side surfaces. The upper surface of the body member is textured to simulate any desired type of surface. Suitable channels, extending longitudinally from the forward surface toward the rear surface, may be incorporated into the body member to simulate the division between adjacent shingles in the same course. A top plate (e.g., thin sheet of plywood) is coupled to the upper surface of the body member on a rear portion thereof and extends laterally between the side surfaces and extends longitudinally forwardly from the rear surface toward the front surface and allows nailing at any desired transverse position. A bottom plate is coupled to the lower surface of the body member and extends laterally between the side surfaces. The bottom plate has a back edge that is spaced a preselected longitudinal distance from the rear surface of the body member and has a front portion that extends longitudinally forwardly from the base portion of the first walls of the body member towards the forward surface of the body member. Hardy also provides a separate structural element that may be fabricated in lengths similar to that provided for the course of simulated shingles that is utilized as an eaves starter. The

eaves starter strip is virtually identical to the rear portion of the course of shingles and is provided with a top plate and, if desired, the rear-most portion of the bottom plate.

The Hardy starter strip is therefore specifically designed to be used with the Hardy simulated shingles. The Hardy patent is therefore nothing more than a part of the background of the unsolved need for Appellant's invention. The fact that Hardy does not teach or suggest a starter block that is usable with different types of shingles and that prevent the first course of shingles from substantially bending demonstrates that Hardy had no knowledge of the problem addressed by the present invention. Therefore, the Hardy patent contains no explicit or implicit teaching that is actually relevant to the present claimed invention. Such objective evidence of nonobviousness must be considered if presented. Pentech, Inc. v. Graphic Controls Corp., 776 F.2d 309, 315, 227 USPQ 766, 770 (Fed. Cir. 1985).

In determining whether obviousness is established by the teachings of the prior art, "the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art." Cable Electric Products, Inc. v. Genmark, Inc., 770 F.2d 1015, 1025, 226 USPQ 881, 886-887 (Fed. Cir. 1985); In re GPAC, 35 USPQ at 1123. To invalidate claimed subject matter for obviousness, the combined teachings of the prior art references must suggest, expressly or by implication, the improvements embodied by the present invention. In re Sernaker, 702 F.2d 989, 217 USPQ 1 (Fed. Cir. 1983).

"In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based on the prior art." In re Fritch, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). "Obviousness cannot be established by

combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under Section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so.” ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

The Examiner, in both the non-final and final rejection, acknowledged that the Hardy reference does not contain within its four corners a teaching adequate to support the obviousness rejection and, faced with this deficiency, the Examiner has resorted to dubious, undocumented assertions of what would have been obvious to one skilled in the art based on a reading of Hardy.

Appellant respectfully submits that Hardy does not teach or suggest the claimed invention. In particular, Hardy fails to teach or suggest at least the following elements of Appellant’s claimed invention: (1) a course of composite starter blocks having a unitary construction; and (2) tapered side surfaces wherein a shingle placed flat on the top surface of the starter block will extend back to the roof without substantially bending.

In his rejections, the Examiner states that “Hardy discloses a starter block 11 for facilitating the subsequent positioning of shingles upon a hip roof, the starter block 1 [sic] comprising:” However, independent Claim 12 recites that the course of composite starter blocks have a unitary construction. Both the non-final and the final Office Action utterly fail to even mention much less discuss this feature of Appellant’s invention. Nowhere in either Office Action does the Examiner claim that Hardy teaches a starter block having a unitary construction nor can the Examiner so claim. Rather than a composite starter block having a unitary construction, Hardy teaches that “[f]or the

starting strip, a board 50 may be secured to the underside of the sheathing 10, this board extending beyond the edge of the sheathing and built up as by members 52, 52, the latter conforming in thickness to the thickness of the butt edge of the shingle.” Further, Hardy teaches that the eaves starter strip is virtually identical to the rear portion of the course of shingles and is provided with a top plate and, if desired, the rear-most portion of the bottom plate. These separate components are then assembled together to form Hardy’s eaves starter strip. Thus, Hardy fails to teach or suggest a composite starter block having a unitary construction.

The secondary reference to Gleason also fails to teach or suggest a composite starter block having unitary construction. In fact, Gleason does not teach or suggest starter blocks at all. Rather, Gleason only briefly mentions that “[p]reliminary to applying panels to a roof, a metal starter strip (not shown) is nailed to the roof and extends closely adjacent and parallel to the eave.” Furthermore, the Examiner makes no claim that Gleason does teach or suggest a composite starter block having a unitary construction.

Moreover, the Examiner offers no explanation or factual justification for his extrapolation of the Hardy and Gleason patents to the present claimed invention. Rather, the Examiner merely states that Appellant’s invention is obvious and does not provide any support or justification whatsoever for how or why these references teach or suggest a composite starter block having a unitary construction. However, the burden is on the Examiner to show that Appellant’s claimed invention is disclosed in the cited references. The Examiner has not met his burden with respect to this feature of Appellant’s claimed invention.

With respect to the second feature of Appellant's claimed invention, namely, tapered side edges wherein a shingle placed flat on the top surface of the starter block will extend back to the roof without substantially bending, it is admitted in the Office Action that Hardy fails to teach or suggest tapered side edges. However, it is asserted that "tapered side edges is [sic] known in the art of shingles as shown by Gleason et al., element 14, figure 3." Appellant respectfully submits that this combination is inapposite. First, there is no teaching or suggestion in Gleason to provide a starter block at all. Gleason only teaches shingles. The sole teaching by Gleason is for a metal starter strip as discussed above. In response to Appellant's previously-submitted arguments in this vein, the Office Action states that "[r]eason [sic] expectation of success has been shown such as ease of installation. The prior art suggest [sic] the claimed limitation or the limitations are with in [sic] the scope of the inventions of the prior art. The prior art teaches the claimed limitations thus the same may be termed a starter block. The secondary references are not bodily incorporated into the teaching of the base references but are cited to show some favorable feature known in the building or roof industry." Appellant respectfully traverses this mischaracterization of what constitutes a prima facie case of obviousness.

First, the Office Action has failed to demonstrate the suggestion or motivation, present either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the reference teachings as required by the first criteria of obviousness. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 16 USPQ2d 1430 (Fed. Cir. 1990). The

Office Action appears to be asserting that, because the Gleason reference allegedly contains tapered side edges, “the prior art teaches the claimed limitations thus the same may be termed a starter block.” Appellant respectfully submits that just because the shingles taught by Gleason allegedly possess tapered side edges that does not mean that the shingles somehow become starter blocks. There is absolutely no suggestion or motivation in Hardy or Gleason to combine a feature of Gleason’s shingles with Hardy’s starter strip. In fact, this combination would render Hardy’s starter strip unsatisfactory for its intended purpose. Hardy discloses a dependent starter system. That is, Hardy requires a specific starter/shingle alignment due to the interlocking nature of the starter strip and shingle. As a result, Hardy’s starter strip cannot be used with any shingle system but can only be used with Hardy’s shingle. Adding tapered edges to Hardy’s starter strip would destroy the anchoring nature of the starter strip and shingle and would render it inoperable for use with Hardy’s shingles because Hardy’s shingles are formed from poured concrete. Furthermore, the proposed modification to Hardy’s starter strip would, even if operable, still not allow a shingle to lie flat on the starter strip and extend back to the roof without substantially bending. Since the proposed modification of Hardy would render Hardy’s starter strip unsatisfactory, no suggestion or motivation to make the proposed modification exists. In re Gordon, 221 USPQ 1125 (Fed. Cir. 1984).

Moreover, Appellant respectfully submits that Gleason does not, in fact, teach tapered side edges at all. Element 14 in figure 3 does not designate a tapered side edge of the shingle as asserted by the Examiner, but rather designates the lower edge 14 of roofing panel 10. *See* Col. 2, lines 10-16. Rather, Gleason teaches a roofing “panel that includes an upper, relatively straight-line edge, two side edges at substantially 90 degrees

to the upper edge, and a lower, irregular edge having the appearance of a plurality of individual roofing shakes.” Col. 1, lines 29-35. Moreover, “[t]he undersurface of each panel includes a *stepped* arrangement” (*emphasis added*) Col. 1, lines 45-46.

As discussed above, neither Hardy nor Gleason teach or suggest a composite starter block having a unitary construction and tapered side edges wherein a shingle placed flat on the top surface of the starter block will extend back to the roof without substantially bending. Similarly, Hudson also fails to teach or suggest a composite starter block having a unitary construction and tapered side edges wherein a shingle placed flat on the top surface of the starter block will extend back to the roof without substantially bending. Rather, Hudson is asserted to merely teach “a course of starter shingles commensurate in dimension with the shingles.” Kirkhuff appears to be cited only to support the conclusion that “[i]t would have been obvious to one having ordinary skill in the art to modify Hardy to include a starter strip commensurate in dimension with the starter shingle in order to facilitate installation as suggested by Hudson and Kirkhoff [sic].” It has already been discussed hereinabove that Kirkhuff utterly fails to teach or suggest a composite starter block having a unitary construction and tapered side edges wherein a shingle placed flat on the top surface of the starter block will extend back to the roof without substantially bending.

Prima facie obviousness requires that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references. No such suggestion or motivation exists in Hardy, Kirkhuff, Gleason or Hudson to provide a composite starter block having unitary construction and tapered side edges wherein a shingle placed flat on

the top surface of the starter block will extend back to the roof without substantially bending. Moreover, there is no expectation of success in the combination of Hardy, Kirkhuff, Gleason and Hudson since none of these references discloses these elements of Appellant's claimed invention and the proposed modification of Hardy would render Hardy's starter strip inoperable for its intended purpose. Finally, the prior art references must teach or suggest all the claim limitations. As discussed above, none of the cited references teach or suggest all of the elements of Appellant's independent Claim 12. Unless all the elements are taught by the references, there can be no success in modifying them.

Thus, at the time the present invention was made, the cited references to Hardy, Kirkhuff, Gleason and Hudson all fail to teach or describe all of the limitations claimed by Appellant in independent Claim 12 and the claims depending therefrom. Accordingly, Claims 12-15 and 19-23 are nonobvious under § 103(a) and Appellant respectfully requests that this rejection be reversed.

F. Claim 16 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Hardy in view of Kirkhuff in view of Gleason further in view of Hudson, Jr. as applied to Claim 12 and further in view of Earhardt.

(1) The Rejection

In particular, the Final Office Action stated that "[t]he nailing zone is not indented as shown by Earhardt et al, see abstract. It would have been obvious to one of ordinary skill in the art to modify hardy [sic] to include the indented nailing zone to accommodate proper placement of the nail upon installation of the starter block and shingles as shown by Earhardt." Appellant has interpreted this statement to mean that it is the Hardy reference that does not teach a nailing zone.

(2) Discussion

As discussed above, Hardy, Kirkhuff, Gleason, and Hudson all fail to teach or suggest a composite starter block having a unitary construction and tapered side edges wherein a shingle placed flat on the top surface of the starter block will extend back to the roof without substantially bending. Moreover, these references also fail to teach or suggest a nailing zone indented into the top surface of the starter block. Similarly, Earhardt also fails to teach or suggest a composite starter block having a unitary construction, tapered side edges, and a nailing zone indented into the top surface of the starter block. Rather, Earhardt merely teaches a plastic shim for use in building. The asserted “nailing zone” taught by Earhardt serves a different purpose than that of the claimed invention. Earhardt’s nailing divot is not for ensuring proper nail placement but rather for weakening the fastening strength of the nail by causing the shim to split in the indented area.

Furthermore, Earhardt is not analogous art. In order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the invention was concerned. In re Oetiker, 24 USPQ2d 1443 (Fed. Cir. 1992). Appellant’s field of endeavor relates to roofing and, in particular, a starter block for roofing shingles. The Earhardt reference, on the other hand, is directed to shims which are used to fill gaps, level items such as doors, windows or cabinets, or to adjust such items to fit properly. This reference deals with completely different subject matter and would not logically have commended itself to the inventor’s attention in considering the problem at hand in the present invention.

Prima facie obviousness requires that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references. No such suggestion or motivation exists in Hardy, Kirkhuff, Gleason, Hudson or Earhardt to provide a composite starter block having unitary construction, tapered side edges wherein a shingle placed flat on the top surface of the starter block will extend back to the roof without substantially bending, and a nailing zone indented into the top surface. One skilled in the art would also not look to Earhardt for motivation because it is nonanalogous art. Moreover, there is no expectation of success in the combination of Hardy, Kirkhuff, Gleason, Hudson and Earhardt since none of these references disclose a composite starter block having unitary construction, tapered side edges wherein a shingle placed flat on the top surface of the starter block will extend back to the roof without substantially bending, and a nailing zone indented into the top surface of the starter block. Finally, the prior art references must teach or suggest all the claim limitations. As discussed above, Hardy, Kirkhuff, Gleason, Hudson and Earhardt all fail to teach or suggest all of the elements of Appellant's independent Claim 12. Unless all the elements are taught by the references, there can be no success in modifying them.

Thus, at the time the present invention was made, the cited references, alone or in combination, all fail to teach or describe all of the limitations claimed by Appellant in independent Claim 12 and its dependent Claim 16. Accordingly, Claim 16 is nonobvious under § 103(a) and Appellant respectfully requests that this rejection be reversed.

G. Claims 17-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hardy in view of Kirkhuff in view of Gleason

further in view of Hudson, Jr. as applied to Claim 12 and further in view of Bussey.

(1) The Rejection

In particular, the Final Office Action states that “Hardy lacks the nibs from the side surfaces of the shingle/starter block [sic] Bussey discloses nibs 24/25/26 extending from the side surface of his roofing shingle 27. It would have been obvious to one of ordinary skill in the art to include these nibs on nibs [sic] on the starter bloc/shingle [sic] of kirkhoff [sic] to provide an aligning means upon installation of the starter block/shingles on the roof.”

(2) Discussion

As discussed above, Hardy, Kirkhuff, Gleason, and Hudson all fail to teach or suggest a composite starter block having a unitary construction and tapered side edges wherein a shingle placed flat on the top surface of the starter block will extend back to the roof without substantially bending. Moreover, these references also fail to teach or suggest a nib extending from a side surface. Similarly, Bussey also fails to teach or suggest a composite starter block having a unitary construction, tapered side edges wherein a shingle placed flat on the top surface of the starter block will extend back to the roof without substantially bending, and a nib extending the a side surface. Rather, Bussey merely teaches metallic shingles that are symmetrical, reversible and interlockable. Contrary to the Office Action’s assertions, the “nib” taught by Bussey is not a spacer. Rather, it is an integral part of Bussey’s interlocking system. In the present invention, the claimed nib or spacer tab ensures consistent spacing.

Prima facie obviousness requires that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references. No such suggestion or motivation exists in Hardy, Kirkhuff, Gleason, Hudson or Bussey to provide a composite starter block having unitary construction, tapered side edges wherein a shingle placed flat on the top surface of the starter block will extend back to the roof without substantially bending, and a nib extending from a side surface. Moreover, there is no expectation of success in the combination of Hardy, Kirkhuff, Gleason, Hudson and Bussey since none of these references disclose these elements of Appellant's claimed invention. Finally, the prior art references must teach or suggest all the claim limitations. As discussed above, Hardy, Kirkhuff, Gleason, Hudson and Bussey all fail to teach or suggest all of the elements of Appellant's independent Claim 12. Unless all the elements are taught by the references, there can be no success in modifying them.

Thus, at the time the present invention was made, Hardy, Kirkhuff, Gleason, Hudson and Bussey, alone or in combination, fail to teach or describe all of the limitations claimed by Appellant in independent Claim 12 and its dependent Claims 17-18. Accordingly, Claims 17-18 are nonobvious under § 103(a) and Appellant therefore respectfully requests reversal of this rejection.

H. MPEP § 707.07(f)

Finally, Appellant respectfully submits that it has not been given the benefit of a full and complete examination. In particular, the Examiner has repeatedly failed to address or respond to the arguments the Appellant presented in its Amendments responsive to both Office Actions. According to MPEP § 707.07(f), "[w]here the

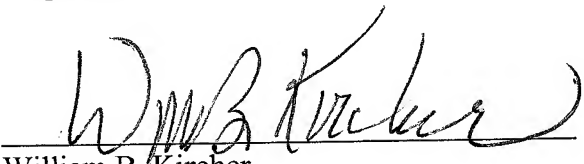
applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." The Examiner has not done so here.

VIII. Conclusion

For the foregoing reasons, it is respectfully submitted that the pending claims patentably distinguish over the applied prior art and should be deemed to be allowable. Appellant thus courteously requests that the rejection of claims 1-23 as unpatentable over the prior art be reversed. Should any fees be necessitated by this response, the Commissioner is hereby authorized to deduct such fees from Deposit Account No. 11-0160.

Respectfully submitted,

Date: 4/9/2007


William B. Kircher
Reg. No. 22,481
Blackwell Sanders Peper Martin LLP
4801 Main St., Suite 1000
Kansas City, MO 64112
816-983-8000
ATTORNEYS FOR APPELLANT

IX. Claims Appendix

1. A composite starter block having a unitary construction for facilitating the subsequent positioning of shingles upon a hip roof, said starter block comprising:

a top surface, two side surfaces, a front surface and a back surface;

wherein each of said top surface, said front surface and said back surface has a generally rectangular shape;

wherein the height of said front surface is greater than the height of said back surface;

wherein said two side surfaces are tapered; and

wherein a shingle placed flat on said top surface will extend back to said roof without substantially bending.

2. The starter block of claim 1 wherein the width of said starter block is substantially equal to the width of said shingle.

3. The starter block of claim 1 wherein the length of said starter block is substantially equal to the length of said shingle.

4. The starter block of claim 1 further comprising at least one nailing zone on said top surface.

5. The starter block of claim 4 wherein said at least one nailing zone is indented into said top surface.

6. The starter block of claim 1 further comprising a first nib extending from one of said side surfaces.

7. The starter block of claim 6 further comprising a second nib extending from the opposite side surface.

8. The starter block of claim 1 wherein said composite material is a combination of at least a polymer component and a filler component.

9. The starter block of claim 1 wherein the height of said front surface is about twice the height of said back surface.

10. The starter block of claim 1 wherein the height of said front surface is 0.5 inches and said height of said back surface is 0.25 inches, and wherein the length of said top surface is 10 inches and the width of said top surface is 12 inches.

11. The starter block of claim 1 wherein said top surface is configured to resemble slate.

12. A roofing system for covering and protecting a roof, said roofing system comprising:

a course of starter blocks coupled to the eaves of said roof, with each of said starter blocks having a unitary construction and comprising a top surface, two side surfaces, a front surface and a back surface, wherein each of said top surface, said front surface and said back surface has a generally rectangular shape; wherein the height of said front surface is greater than the height of said back surface; and wherein said two side surfaces are tapered; and

at least one course of shingles coupled to said roof, the first course of said shingles positioned to lie flat on and at least partially overlap said course of starter blocks with said shingles extending back to said roof without substantially bending.

13. The roofing system of claim 12 wherein the width of each of said starter blocks is substantially equal to the width of one of said shingles.

14. The roofing system of claim 12 wherein the length of each of said starter blocks is substantially equal to the length of one of said shingles.

15. The roofing system of claim 12 wherein said starter blocks each have at least one nailing zone on their top surface.

16. The roofing system claim 15 wherein said nailing zones are indented into said top surface.

17. The roofing system of claim 12 wherein said starter blocks each have a first nib extending from one of said side surfaces.

18. The roofing system of claim 17 wherein said starter blocks each have a second nib extending from the opposite side surface.

19. The roofing system of claim 12 wherein said starter blocks and said shingles are formed from a composite material.

20. The roofing system of claim 19 wherein said composite material is a combination of at least a polymer component and a filler component.

21. The roofing system of claim 19 wherein the top surface of said starter blocks and said shingles are configured to resemble slate.

22. The roofing system of claim 12 wherein the height of said starter block front surface is about twice the height of said starter block back surface.

23. The roofing system of claim 12 wherein the height of said starter block front surface is 0.5 inches and said height of said starter block back surface is 0.25

Application of: Randal J. Jolitz
Application No. 10/757,145
Appeal Brief

inches, and wherein the length of said starter block top surface is 10 inches and the width of said starter block top surface is 12 inches.

Application of: Randal J. Jolitz
Application No. 10/757,145
Appeal Brief

X. Evidence Appendix

None

Application of: Randal J. Jolitz
Application No. 10/757,145
Appeal Brief

XI. Related Proceedings Appendix

None.